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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,124	12/22/2000	Kazunori Arima	862.C2075	7920

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EXAMINER	
USTARIS, JOSEPH G	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/742,124	ARIMA, KAZUNORI	
	Examiner	Art Unit	
	Joseph G. Ustaris	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 24 November 2004 in application 09/742,124.

The 35 U.S.C. 112, second paragraph, rejection of claims 7-18, 25-36, and 39-50 are now withdrawn in view of the amendments.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 15-24, 35-38, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey et al. (4,704,725) in view of Tanaka et al. (US006588012B2).

Regarding claim 1, Harvey et al. (Harvey) discloses a cable converter box, tuner, and signal processor that function together as a "digital broadcast receiving apparatus" (See Fig. 6D). The cable converter box, tuner, and signal processor has a "means for receiving digital broadcast of the program" (See column 20 lines 22-43) and "extracting information" (See column 20 lines 25-43). The supplemental data or "extracted information", that includes a recipe, is then transferred to a printer or "printing means for print-outputting the extracted information" (See column 20 lines 52-64). However,

Harvey does not disclose a "means for setting a digital broadcast program and contents provided in the program, in advance".

Tanaka et al. (Tanaka) discloses a combination terminal unit that receives various signals such as CATV signals. The combination terminal unit allows users to reserve/schedule a TV program or "means for setting a digital broadcast program" and the type of topics of the TV program or "contents provided in the program" the user wishes to receive, in advance (See Fig. 3, 4, 15, 16 "Alert Screen", and 18; column 5 lines 10-20 and 36-45). Inherently thereafter, the terminal receives the TV program and topics "related to the set contents" and offers the user the option to record the TV program. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable converter box, tuner, and signal processor disclosed by Harvey to perform a "means for setting a digital broadcast program and contents provided in the program, in advance", as taught by Tanaka, in order to provide a means of alerting or reminding the user of TV programs that are of interest to the user thereby providing more convenience for the user.

Claim 2 contains the limitations of claim 1 (wherein the cable converter box, tuner, and signal processor has an "output means" to transfer data to the printer (See Harvey Fig. 6D)) and is analyzed as previously discussed with respect to that claim.

Claim 3 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Harvey in view of Tanaka further discloses that the cable converter box, tuner, and signal processor has a "designation means" that allows a user to "designate print-output of information" (See Harvey column 20 lines 25-33).

The "designation of the program and the contents" is stored in the buffer/comparator in order to allow the receiver to receive the contents (See Harvey column 20 lines 22-43). The supplemental data or "contents" is then printed at the next broadcast of information or "means for performing print-output of information related to the designated contents as to the designated program in accordance with the stored designation at the next and subsequent broadcast times" (See Harvey column 20 lines 33-53).

Claim 4 contains the limitations of claim 3 (wherein the cable converter box, tuner, and signal processor has an "means for outputting" to transfer data to the printer (See Harvey Fig. 6D)) and is analyzed as previously discussed with respect to that claim.

Regarding claim 5, the system stores "the designation into said storage means only in accordance with designation from an operator" (See Harvey column 20 lines 25-43).

Claim 6 contains the limitations of claims 4 and 5 and is analyzed as previously discussed with respect to those claims.

Regarding claim 15, Harvey in view of Tanaka does not disclose a "means for judging whether or not said printing means is in a normal status and means for storing said information if said printing means is not in the normal status".

Official Notice is taken that it is well known to check the status of a printer and to store the print job if the printer is not available. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable converter box, tuner, signal processor, and printer disclosed by Harvey in view of

Tanaka to include a means for checking if the printer is in "normal status" and to store the print job or also known as "extracted information" if the printer is not available or "not in the normal status" in order to ensure that the "information" is successfully printed or that the "extracted information" is not lost or erased if the printer is not available.

Claim 16 contains the limitations of claims 2 and 15 and is analyzed as previously discussed with respect to those claims.

Claim 17 contains the limitations of claims 3 and 15 and is analyzed as previously discussed with respect to those claims.

Claim 18 contains the limitations of claims 4 and 15 and is analyzed as previously discussed with respect to those claims.

Claim 19 contains the limitations of claim 1 (wherein the system performs the method) and is analyzed as previously discussed with respect to that claim.

Claim 20 contains the limitations of claim 3 (wherein the system performs the method) and is analyzed as previously discussed with respect to that claim.

Claim 21 contains the limitations of claim 1 (where inherently the system and system components are run by "computer programs") and is analyzed as previously discussed with respect to that claim.

Claim 22 contains the limitations of claim 3 (where inherently the system and system components are run by "computer programs") and is analyzed as previously discussed with respect to that claim.

Claim 23 contains the limitations of claim 2 (where inherently the system includes a "transmitting apparatus" in order for the cable converter box, tuner, and signal

processor that function together as a "receiving apparatus" to receive broadcasts/signals) and is analyzed as previously discussed with respect to that claim.

Claim 24 contains the limitations of claim 4 (where inherently the system includes a "transmitting apparatus" in order for the cable converter box, tuner, and signal processor that function together as a "receiving apparatus" to receive broadcasts/signals) and is analyzed as previously discussed with respect to that claim.

Claim 35 contains the limitations of claims 15 and 23 and is analyzed as previously discussed with respect to those claims.

Claim 36 contains the limitations of claims 15 and 24 and is analyzed as previously discussed with respect to those claims.

Claim 37 contains the limitations of claim 1 and 23 (wherein the system performs the method) and is analyzed as previously discussed with respect to those claims.

Claim 38 contains the limitations of claim 3 and 24 (wherein the system performs the method) and is analyzed as previously discussed with respect to those claims.

Claim 49 contains the limitations of claims 35 and 37 and is analyzed as previously discussed with respect to those claims.

Claim 50 contains the limitations of claims 36 and 38 and is analyzed as previously discussed with respect to those claims.

Claims 7-14, 25-28, and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey et al. (4,704,725) in view of Tanaka et al. (US006588012B2)

as applied to claims 1-6, 15-24, 35-38, 49, and 50 above, and further in view of Jones et al. (US005978013A).

Regarding claim 7, Harvey in view of Tanaka does not disclose a "means for judging whether or not print-output of the extracted information is permitted and means for prohibiting print-output of the extracted information if the print-output is not permitted".

Harvey in view of Tanaka uses a Cooking show and supplemental data that includes recipes to demonstrate their system, inherently the system is capable of receiving different types of TV programs with varying types of information included in the supplemental data (See Harvey column 20 lines 16-25). Jones et al. (Jones) discloses a system where coupons are embedded in the TV signal and the subscriber receives the signals and prints the coupons (See Fig. 10). The subscriber's unit is able to determine if printing the coupon is allowed or "means for judging whether or not print-output of the extracted information is permitted" and prohibits printing the coupon if it had been printed before or "means for prohibiting print-output of the extracted information if the print-output is not permitted" (See column 14 line 37 – column 15 line 5; column 16 lines 9-24). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable converter box, tuner, signal processor, and printer disclosed by Harvey in view of Tanaka to include a "means for judging whether or not print-output of the extracted information is permitted and means for prohibiting print-output of the extracted information if the print-output is

not permitted", as taught by Jones, in order to prevent multiple printed copies of the "information" extracted from the program by one user/subscriber.

Claim 8 contains the limitations of claims 2 and 7 and is analyzed as previously discussed with respect to those claims.

Claim 9 contains the limitations of claims 3 and 7 and is analyzed as previously discussed with respect to those claims.

Claim 10 contains the limitations of claims 4 and 7 and is analyzed as previously discussed with respect to those claims.

Claim 11 contains the limitations of claim 7 (wherein the supplemental data or "extracted information" includes coupon data or "information part" where the subscribers unit is able to determine if printing the coupon is allowed and to prevent printing if its not allowed) and is analyzed as previously discussed with respect to that claim.

Claim 12 contains the limitations of claims 2 and 11 and is analyzed as previously discussed with respect to those claims.

Claim 13 contains the limitations of claims 3 and 11 and is analyzed as previously discussed with respect to those claims.

Claim 14 contains the limitations of claims 4 and 11 and is analyzed as previously discussed with respect to those claims.

Claim 25 contains the limitations of claims 7 and 23 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 26 contains the limitations of claims 7 and 24 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 27 contains the limitations of claims 11 and 23 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 28 contains the limitations of claims 11 and 24 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 39 contains the limitations of claims 25 and 37 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 40 contains the limitations of claims 26 and 38 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 41 contains the limitations of claims 27 and 37 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast

program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 42 contains the limitations of claims 28 and 38 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claims 29-34 and 43-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey et al. (4,704,725) in view of Tanaka et al. (US006588012B2) and in further view of Jones et al. (US005978013A) as applied to claims 7-14, 25-28, and 39-42 above, and further in view of Mori (US006089765A).

Regarding claim 29, Harvey in view of Tanaka does disclose "information" that is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)). However, Harvey in view of Tanaka and further in view of Jones does not disclose that the supplemental data is transmitted as (1) "a header and a main body" and (2) the "header indicates whether or not print-output of the information is permitted, and wherein said judgment means of receiving apparatus reads header and judges whether or not the extracted information is information without print permission".

(1) Official Notice is taken that it is well known to transmit data in the form of packets, where the packets include a "header and a main body". Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was

made to modify the "transmitting apparatus" disclosed by Harvey in view of Tanaka and in further view of Jones to transmit supplemental data as packets that include a "header and a main body" in order to conform to a well known standard thereby increasing the compatibility of the system.

(2) Mori discloses a print system within a network where a computer adds data to the header of print data indicating whether printing the data is allowed or not or a "header indicates whether or not print-output of the information is permitted". The printer inherently reads the header and judges whether to print the data or not or "receiving apparatus reads header and judges whether or not the extracted information is information without print permission" (See Fig. 4; column 12 lines 7-25). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the supplemental data, cable converter box, tuner, signal processor, and printer disclosed by Harvey in view of Tanaka and in further view of Jones to have a "header that indicates whether or not print-output of the information is permitted, and the receiving apparatus reads header and judges whether or not the extracted information is information without print permission", as taught by Mori, in order to increase the efficiency of the system by providing a standard location for printing instructions thereby making it easier to locate and to prevent multiple printed copies.

Claim 30 contains the limitations of claims 26 and 29 and is analyzed as previously discussed with respect to those claims.

Claim 31 contains the limitations of claims 27 and 29 and is analyzed as previously discussed with respect to those claims.

Claim 32 contains the limitations of claims 28 and 31 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 33 contains the limitations of claims 11, 27, and 29 and is analyzed as previously discussed with respect to those claims. However, Harvey in view of Tanaka and further in view of Jones and Mori does not disclose that the "main body" of the supplemental data includes a "plurality of blocks".

Official Notice is taken that it is well known that packets can include multiple blocks of data or a "plurality of blocks", where each block represents different data, i.e. multiple coupon data from various sources. Therefore, it would been obvious to one with ordinary skill in the art at the time the invention was made to modify the supplemental data disclosed by Harvey in view of Tanaka and in further view of Jones and Mori to have a "main body comprising a plurality of blocks", where each block represents different data, in order to increase the transfer rate of the supplemental data by increasing the payload of each packet.

Furthermore, each "block" represents different data, i.e. different coupon data. Inherently each block would have a header identifying each data, i.e. coupon data, where each header includes printing instructions or "including blocks of information part without permission and blocks of the another information part" as taught by Mori above. The printer inherently reads the header and judges whether to print the data or not or

"receiving apparatus reads header of block and judges whether or not print-output of the block is permitted".

Claim 34 contains the limitations of claims 28 and 33 and is analyzed as previously discussed with respect to those claims.

Claim 43 contains the limitations of claims 29 and 39 and is analyzed as previously discussed with respect to those claims.

Claim 44 contains the limitations of claims 30 and 40 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 45 contains the limitations of claims 31 and 41 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 46 contains the limitations of claims 32 and 42 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Harvey column 9 lines 25-40 and column 20 lines 37-43)) and is analyzed as previously discussed with respect to those claims.

Claim 47 contains the limitations of claims 33 and 41 and is analyzed as previously discussed with respect to those claims.

Claim 48 contains the limitations of claims 34 and 42 and is analyzed as previously discussed with respect to those claims.

Response to Arguments

3. Applicant's arguments filed 24 November 2004 have been fully considered but they are not persuasive.

Applicant argues with respect to claim 1 that Harvey does not disclose or suggest a digital broadcast receiving apparatus. Applicant further extends this argument to claims 2-4, 19-24, 37, and 38. However, Harvey does disclose that the receiver receives a digital signal, thus meeting the limitation of a "digital broadcast receiving apparatus". The recipe disclosed by Harvey is encoded and received in digital form (See Harvey column 20 lines 37-43). Furthermore, Harvey discloses that digital signals are embedded and transmitted in a television signal, thus making the "digital broadcast program" (See column 9 lines 25-40).

Applicant further argues that Harvey and Tanaka does not disclose or suggest allowing the user to set the device in advance to print out the contents provided in a program. However, Tanaka does disclose a method that allows a user to reserve/schedule a TV program and the type of topics of the TV program or "means for setting a digital broadcast program and contents provided in the program" in advance. Therefore, Harvey with the teachings from Tanaka allows the users to set the device in advance, and print out the contents provided in a program as disclosed by Harvey (See claim rejections). It is noted that the prior art system differs substantially from the claimed system. However, such differences are not clearly recited within the claims. Applicant is reminded that although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments with respect to claims 3, 4, 20, 22, 24, and 38 have been considered but are moot in view of the new ground(s) of rejection. Furthermore, it is noted that the features upon which applicant relies (i.e., recurring digital broadcast programs and where the user does not need to operate the receiving apparatus every week) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGU
May 19, 2005

VIVEK SRIVASTAVA
PRIMARY EXAMINER